

3/14/02

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 9  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Smart Belt Corp. of America

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Serial No. 75/763,106

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C. Robert Rhodes of Womble Carlyle Sandridge & Rice, PLLC  
for Smart Belt Corp. of America.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office  
104 (Sidney I. Moskowitz, Managing Attorney).

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Before Hanak, Walters and Chapman, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 29, 1999, Smart Belt Corp. of America filed an  
application, based on Section 1(a) of the Trademark Act, 15  
U.S.C. §15 U.S.C. §1051(a), (applicant claimed a date of  
first use of November 6, 1996), to register the mark SMART  
BELT on the Principal Register for goods ultimately  
identified as "packaging machines for use in the food  
packaging industry" in International Class 7.

The Examining Attorney refused registration under  
Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e),  
on the basis that, when used on or in connection with

applicant's goods, the term SMART BELT is merely descriptive of them.

When the refusal was made final,<sup>1</sup> applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney submitted excerpts from The American Heritage Dictionary (Third Edition 1992) defining the term "smart" as "of, relating to, or being a highly automated device, especially one that imitates human intelligence," and the term "belt" as "a continuous band or chain for transferring motion or power or conveying

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<sup>1</sup> The first Examining Attorney initially refused registration of the entire mark on the ground of mere descriptiveness, required a disclaimer of the term "belt" asserting it is a merely descriptive term, and invited applicant to consider the Supplemental Register. Applicant submitted a disclaimer of the term "belt." The second Examining Attorney made the refusal to register on mere descriptiveness final; stated in a footnote that "the proposed mark as a whole appears to be generic" (emphasis in original), and that applicant's disclaimer of the term "belt" was not accepted and would be entered only if the mark is determined to be otherwise registrable; and withdrew the offer of registration on the Supplemental Register. She also utilized the term "generic" in the body of the Final Office action, but she did not issue a clear, and separate refusal to register on that basis. In its brief, applicant expressed the issue in this case as whether the mark is merely descriptive (unnumbered p. 2). In the Examining Attorney's brief, she acknowledged that applicant was advised in the Final Office action "for the first time that the proposed mark appears to be a generic name for the goods" (footnote 2); but the body of the brief made no mention of genericness, referring only to mere descriptiveness throughout. Thus, we find that there is no refusal to register in this case on the ground that the mark is generic. We emphasize that any refusal(s) to register and the statutory ground(s) therefore must be clearly set forth in the Office actions. See TMEP §§1105.04(c) and 1106.01.

materials from one wheel or shaft to another." She contends that the term SMART BELT is used in conjunction with packaging machines as evidenced by various excerpted stories retrieved from the Nexis database and from the Internet; that "the proposed mark is merely descriptive because, absent any limitations in the identification of goods, it is presumed that automated belts are a feature of the applicant's packaging machines" (brief, p. 3); that "applicant's food packaging machines contain smart belt technology" (brief, p. 6); and that therefore, the term SMART BELT merely describes a feature of applicant's goods.

Applicant argues that the Examining Attorney's evidence establishes, at best, that "SMART BELT" is descriptive for automated conveyor belts, but does not establish a prima facie case that the term is merely descriptive of applicant's goods, "packaging machines for use in the food packaging industry"; and that the mark SMART BELT does not in any clear or precise way merely describe applicant's packaging machines. Applicant specifically stated in the record that "the [conveyor] belts, in and of themselves, are not capable of carrying out the automated function. In fact, some of the equipment sold by [applicant] does not even include conveyor belts." (brief, unnumbered p. 4).

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

In the present case, applicant's mark is used on labels apparently affixed to the goods. The specimen in this case is a photograph of what appears to be a metal

label affixed to a large flat metal object, presumably one side of applicant's packaging machine. The specimen photograph is barely legible due to the photographic flash or reflection off the metal. In fact, the only legible words on the metal label (which themselves are barely readable) are "SMART BELT." The Examining Attorneys who examined this application did not request either a clearer specimen, or information on applicant's goods pursuant to Trademark Rule 2.61(b). See also TMEP §1105.02.

The burden of proving that applicant's mark is merely descriptive rests with the Examining Attorney. Viewing this record in its entirety, we find that the Examining Attorney has not established a prima facie showing that the mark SMART BELT is merely descriptive of applicant's identified goods, "packaging machines for use in the food packaging industry." The evidence may establish that SMART BELT is merely descriptive of an automated conveyor belt; the critical question, however, is whether the mark SMART BELT is merely descriptive of the identified goods. See *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1993).

Applicant has stated that not all of its products include a conveyor belt, and that the belts themselves are not necessarily automated or "smart." The evidence of record does not establish that conveyor belts, automated or

not, are a significant feature of packaging machines.<sup>2</sup> It is true, as asserted by the Examining Attorney, that applicant's identification of goods does not exclude conveyor belts as part of the packaging machines. However, the Board is aware of no requirement that all parts of a "machine" be listed in an identification of goods. Further, the key question not answered by the Examining Attorney's evidence is whether conveyor belts are significant features or parts of packaging machines.

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubt in favor of the applicant and pass the application to publication. See *In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1995); and *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, merely descriptive (or misdescriptive), may oppose and present evidence on this issue to the Board.

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<sup>2</sup> Because the issue of disclaiming "belt" is not before us in this appeal, we have not considered it. However, the Examining Attorney stated that the disclaimer of "belt" would be entered only if the mark was otherwise registrable. Therefore, in view of the decision herein, applicant's disclaimer will be entered and the application will proceed to publication for opposition with a disclaimer of the term "belt."

**Decision:** The refusal to register the mark as merely descriptive under Section 2(e)(1) of the Trademark Act is reversed.